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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,994	08/06/2003	Masahito Kosaka	030914	7422

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EXAMINER

WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/634,994

**Applicant(s)**

KOSAKA ET AL.

**Examiner**

Anthony Weier

**Art Unit**

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-12 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admission of prior art (see Table 4) taken together with either one of U.S. Soyfoods Directory or JP 8-242799.

Applicants admit via Table 4 in the Specification that the products of Control Group 1 and Control Group 15 as being "conventional" products, and therefore, prior art. Specifically, Control group 11 sets forth a cooked green soybean containing beta-carotene of 729 plus or minus 241, which, considering the range of uncertainty overlaps the range requirement of instant claim 5 that the beta-carotene content is not less than 740 ug/100g wet weight. Applicants also admit via Table 4 that the product of Control Group 1 sets forth a green soybean having a chlorophyll a content of 3.7 plus or minus 0.04 g per grams of wet weight as opposed to instant claim 1 calling for green soybean with a chlorophyll a content of not less than 3.8 g/100 g wet weight. It is not seen where the difference between same would make for a patentable distinction as the amount of chlorophyll a between Control Group 1 and the lower limit of the range set forth in claim 1 is so extremely close (i.e. within 0.06 g/100 g taken into account the most favorable range of error). Absent a showing of unexpected results regarding 3.8 g/100 g wet

Art Unit: 1761

weight as opposed that of Control Group 1 (e.g. 3.74 g/100 g wet), it would have been obvious to one having ordinary skill in the art at the time of the invention to have arrived at such amount through general uncertainty error or as a matter of preference in availability of a green soybean that is extremely close to the range called for.

As called for in instant claims 1 and 4, Applicants further admit that it is known to place cooked green soybeans under chilled conditions and in the presence of light (see paragraph 4). It would have been obvious to one having ordinary skill in the art at the time of the invention to have marketed the green soybeans of the control groups mentioned above as a well known distribution procedure in the art.

Although Applicants' admission does not disclose that said soybeans have been previously selected for boiling, it is notoriously well known to boil soybeans for consumption as taught, for example, by either one of U.S. Soyfoods Directory (e.g. first paragraph and paragraph entitled "Green Vegetable Soybeans (Edamame)") or JP 8-242799 (see Abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to have prepared said soybeans in such manner as a matter of preference depending on, for example, the taste or texture desired with said soybeans.

#### ***Allowable Subject Matter***

The prior art of record neither discloses nor teaches a method of producing a boiled green soybean which is preserved or sold under illumination of liquid and wherein said boiled green soybean is suitable for distribution wherein the method includes the step of selecting a green soybean containing chlorophyll or which has been cultivated to

Art Unit: 1761

contain chlorophyll a of not less than 3.8g/100g and beta-carotene of not less than 750 ug/100 g. The prior art (including Applicants' own admission) discloses (or well within the range of obviousness in attaining same) either the chlorophyll or carotene contents of green soybean as called for in the instant claims. However, the prior art does not disclose nor teach why one skilled in the art would have been motivated to have selected a green soybean which is boiled and possesses increased amounts of both chlorophyll a and beta-carotene for preserving same and/or selling under illumination of light and being suitable for chilled distribution.

### ***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 56-1846 and Bruno both teach refrigeration of vegetables in the presence of light.

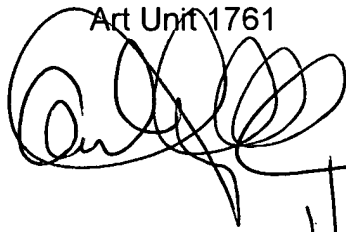
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier  
January 27, 2005

Anthony Weier  
Primary Examiner  
Art Unit 1761

  
1/27/05